



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,900	12/15/1999	ERIC NACE	MCS-116-99	4419
27662	7590	01/06/2005	EXAMINER	
LYON & HARR, LLP 300 ESPLANADE DRIVE, SUITE 800 OXNARD, CA 93036			THOMSON, WILLIAM D	
			ART UNIT	PAPER NUMBER
			2123	

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/461,900

Applicant(s)

NACE ET AL.

Examiner

William D. Thomson

Art Unit

2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal Brief filed on 9-30-2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

1.1 The Examiner notes that an updated search revealed new art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

Art Unit: 2123

international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-40 are rejected under 35 U.S.C. 102(e) as being anticipated by **Landan U.S. Patent 6,449,739**.

2.1 As regards independent **Claims 1, 16, 20 and 39** the *Landan* reference teaches a network simulator (**Figure 1 Items 40 & 36, Col. 1 Lines 32-41, Col. 2 Lines 30-50, Col. 7 Lines 47-57**), a recording module with playback capability (**Figure 1 Items 34, 344 & 38**) the playback capability is functionally equivalent to the report generation (**Figure 1 Item 42 & Figure 19 Item 100**), and a data collection file (**Figure 1 Item 38 note the term "session files" these are functionally equivalent to data collection files**), and filtering with a specific criteria (**Figure 13 & Col. 13 Lines 37-50**).

2.2 As regards dependent **Claims 2-15, 17-19, 21-38 and 40** please see **Figures 1-20 and Columns 1-18**.

3. Independent Claims 1-40 are rejected under 35 U.S.C. 102(e) as being anticipated by **Dantressangle U.S. Patent 6,446,120**.

3.1 As regards independent **Claims 1, 16, 20 and 39** the *Dantressangle* reference teaches a network simulator (**Col. 5 Line 62**), the playback capability is functionally equivalent to the report generation (**Figures 11 & 12**), and a data collection file (**Figures 11 & 12**), and filtering with a specific criteria (**Col. 9 Lines 65-67, Col. 10 Lines 1-14**).

Art Unit: 2123

3.2 As regards dependent **Claims 2-15, 17-19, 21-38 and 40** please see **Figures 1-13 and Columns 1-12.**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Independent **Claims 1-40** are rejected under 35 U.S.C. 102(b) as being anticipated by **Watanabe et al. U.S. Patent 5,761,486.**

4.1 As regards independent **Claims 1, 16, 20 and 39** the *Watanabe et al.* reference teaches a network simulator (**Figure 1 Items 16, 16-1 & 16-2**), with playback capability (**Figure 4 & Col. 6 Lines 48-67, Col. 7 Lines 1-20**), and a data collection file (**Col. 9 Lines 25-32**), and filtering with a specific criteria (**Figure 4 Item S4 note, that the writing of the data collected is based on a “judging” criteria which is the functional equivalent of filtering**).

4.2 As regards dependent **Claims 2-15, 17-19, 21-38 and 40** please see **Figures 1-14 and Columns 1-14.**

Conclusion

5. This Office Action is **NON-Final**. Claims 1-40 are rejected.

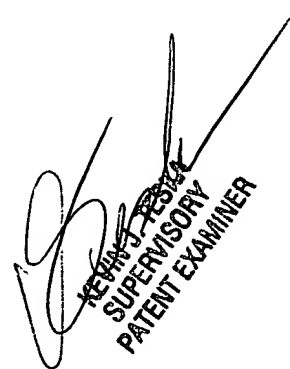
5.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to William D. Thomson whose telephone number is (571) 272-3718. The examiner can normally be reached on 10:00 - 6:00 M-F.

Art Unit: 2123

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on (571)272-3716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WDT


KEVIN T. TESKA
SUPERVISORY
PATENT EXAMINER